REMARKS

Claims 1-22 are currently pending in the application. By this amendment, claims 5, 9 and 17 are amended and new claims 23-25 are added. The above amendments do not add new matter to the application and are fully supported by the specification. For example, support for the amendment to claim 5 is provided at Figures 2 and 5-6, and at pages 8-9 of the specification. Support for the amendment to claim 9 is provided at page 10 of the specification. Support for the amendment to claim 17 is provided at pages 8-10 of the specification. Support for new claims 23-25 is provided at Figures 2 and 9 and pages 10-11 of the specification. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

Claim Rejections - 35 U.S.C. §112 Rejection, First Paragraph

Claims 1-22 were rejected under 35 U.S.C. §112, First Paragraph, Best Mode Requirement, as well as rejected under 35 U.S.C. §112, First Paragraph, Enablement. These rejections are respectfully traversed.

BEST MODE REJECTION

The Examiner asserts the terms "specially formulated urethane material manufactured by a proprietary method" fails to disclose the material best suitable for the rail covers or thimbles of the invention such that one skilled in the art can make and or use the invention. Applicants respectfully disagree with these assertions.

The MPEP 2165.01 (Considerations Relevant to Best Mode) does not require every specific working example necessarily disclose the best mode for there to be evidence of a best mode rejection. The MPEP 2165.01 states that the best mode may be represented by a preferred range of conditions or groups. The Applicants have presented one embodiment ("specially formulated urethane material manufactured by a proprietary method") as one particular embodiment, but the Applicants have not asserted that it is the preferred or only embodiment. In fact, the specification clearly discloses this as one embodiment with additional examples. As a illustration, refer to page 9, lines 5-20 for additional examples.

MPEP 2165.01 recites in part:

SPECIFIC EXAMPLE IS NOT REQUIRED

> There is no statutory requirement for the disclosure of a specific example - a patent specification is not intended nor required to be a production specification. *In re Gay*, 309 F.2d 768, 135 USPQ 311 (CCPA 1962).
>
> The absence of a specific working example is not necessarily evidence that the best mode has not been disclosed, nor is the presence of one evidence that it has. Best mode may be represented by a preferred range of conditions or group of reactants. *In re Honn*, 364 F.2d 454, 150 USPQ 652 (CCPA 1966).

MPEP 2165.03 Requirements for Rejection for Lack of Best Mode [R-1]

ASSUME BEST MODE IS DISCLOSED UNLESS THERE IS EVIDENCE THE CONTRARY

> The examiner should assume that the best mode is disclosed in the application, unless evidence is presented that is inconsistent with that assumption. It is extremely rare that a best mode rejection properly would be made in *ex parte* prosecution. The information that is necessary to form the basis for a rejection based on the failure to set forth the best mode is rarely accessible to the examiner, but is generally uncovered during discovery procedures in interference, litigation, or other *inter partes* proceedings.

Applicants have clearly described materials for the rail covers or thimbles in the specification. For example, the specification discloses:

> "As neoprene rubber is available at a much lower cost than urethane, the two piece rail cover design was used to reduce the overall cost of the gripper kit. In one embodiment, as the formulated urethane has better friction properties than neoprene rubber, it is used at the lower portion of the track rails where slipping problems are the most critical.
> ...Thus, it should also be considered within the scope of this disclosure that one piece or multi-piece construction of the track rail cover can be used for each track rail." (page 9, lines 13-20)

Other material types that can provide similar frictional characteristics and durability are acceptable and should be considered within the scope of this disclosure. (Page 9, lines 5-8) For example, the specification discloses:

> "The urethane material provides sufficient surface friction so that the ball can enter the ball return yet it is flexible enough to avoid damaging the ball while providing sufficient stiffness and resilience to be long lasting over multiple cycles. Other materials that provide similar material properties to urethane are acceptable and should be considered within the scope of this disclosure." (page 10, lines 15-20)

Accordingly, Applicants have defined the type of material that can be used (urethane material or neoprene rubber), along with the material properties of the materials that provide one skilled in the art to make and or use the claimed invention (e.g., "sufficient surface friction, so that the ball can enter the ball return yet it is flexible enough to avoid damaging the ball while providing sufficient stiffness and resilience to be long lasting over multiple cycles").

Applicants, also submit that there is no concealment of the best mode, and submit that other coverings are applicable. Applicants also submit that the Examiner's basis for this rejection is groundless. The MPEP 2165.04 states that evidence must tend to show that the quality of an applicant's best mode disclosure is so poor as to effectively result in concealment.

2165.04 Evidence of Concealment

> In determining the adequacy of a best mode disclosure, only evidence of concealment (accidental or intentional) is to be considered. That evidence must tend to show that the quality of an applicant's best mode disclosure is so poor as to effectively result in concealment.

For reasons stated above, Applicants have disclosed in the specification that neoprene , which is less expensive than the specially formulated urethane, can also be used with the rail covers or thimbles. This would, in the least show that other considerations of best mode may be factored into any equation for concealment of best

mode. Accordingly, Applicants submit that best mode may be based on, for example, cost, effectiveness of material and a list of other factors. With is said, the specially formulated urethane is only one material that can be used, that take into only some considerations, which are applicable to a best mode analysis. For the reasons stated above, there is no concealment of best mode.

Accordingly, Applicants respectfully requests that the Examiner reconsider and withdraw the rejection of the above-noted claims under 35 U.S.C. § 112, first paragraph, Best mode.

ENABLEMENT REJECTIONS

Claims 1-22 were rejected under 35 U.S.C. §112, First Paragraph, Enablement, Applicants respectfully transverse this rejection.

As a preliminary matter, the entire disclosure, including the drawings, provide sufficient disclosure of what is claimed. The terms "specially formulated urethane material manufactured by a proprietary method" is presented in the specification and not in the claims, and the specification provides a complete understanding for one ordinary skilled in the art to make and or use a particular embodiment (not the "only", or preferred embodiment) of the invention. Specifically, the specification clearly describes the material for the rail covers or thimbles, (above page 9, lines 13-17; and page 10, lines10-15).

Applicants respectfully note that such language contains a full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

As is indicated in MPEP 2164.01:

> "[t]he test of enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. United Stated v. Telectronics, Inc., 857 F.2d 778, 8 USPQ2d 1217 (Fed. Cir. 1988); In re Stephens, 188 USPQ 659 (CCPA 1976). The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. In re Angstadt, 190 USPQ 214 (CCPA 1976). An extended period of

> experimentation may not be undue if the skilled artisan is given sufficient direction or guidance. In re Colianni, 195 USPQ 150 (CCPA 1977) (Miller, J., concurring). The experimentation required, in addition to not being undue, must not require ingenuity beyond that expected of one of ordinary skill in the art. In re Angstadt, supra. For example, in one instance a "few hours" of experimentation to determine process parameters was not considered to be undue in view of the nature of the invention (preparation of oxygenated hydrocarbons). In re Borkowski, 164 USPQ 642 (CCPA 1970). In Tabuchi v. Nubel, 194 USPQ 521 (CCPA 1977) a screening procedure which took 15 calendar days was not considered undue experimentation because the test was both simple and straightforward and because of its demonstrated success in producing the desired result.

Applicants submits that each of the above noted commonly known materials would suffice to practice the invention, especially in light of the guidance provided by Applicant's disclosure, which must be considered in evaluating enablement. In particular, Applicants have indicated in paragraphs pages 9-10:

> "Other materials that provide similar material properties to urethane are acceptable and should be considered within the scope of this disclosure." (page 10, lines 15-20)

Applicants also submit that with the materials disclosed in the specification, there would be no undue experimentation required. One of ordinary skill in the art could without undue experimentation, practice the invention using neoprene or other materials providing properties disclosed in the specification. These materials with such properties are well known to ones skilled in the art and do not need further explanation.

Accordingly, Applicants have defined the type of material that can be used (urethane material or neoprene rubber), along with the material properties of the materials that provide one skilled in the art to make and or use the claimed invention without undue experimentation. Such information coupled with the skill and knowledge that one of ordinary skill in the art would have regarding the use of rail covers and the material properties required for the operation of, is more than sufficient to enable the claimed

invention and certainly would not require undue experimentation.

Applicants remind the Examiner of the guidance provided in MPEP 2164.04 which states that:

> "...a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of 35 USC112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support."

In this case, as shown above, there is no reason to doubt the objective truth of the statements made in the specification and similarly there is no concealment or lack of best mode shown.

Accordingly, Applicants respectfully requests that the Examiner reconsider and withdraw the rejection of the above-noted claims under 35 U.S.C. § 112, first paragraph.

Claim Rejections - 35 U.S.C. §112 Rejection, Second Paragraph

INDEFINITNESS REJECTION:

Claims 1-22 were rejected under 35 U.S.C. §112, second paragraph for lack of structural relationships between the elements, along with other assertions. This rejection is respectfully traversed.

Applicants respectfully submit the structural relationship between the elements is not necessary in the claimed invention. The claimed invention is directed to a gripper kit for use in a ball lift mechanism. Applicants submit that one skilled in the art would know the interrelationships of the elements of the ball lift mechanism in which the gripper kit is designed to be used with.

MPEP 2172.01

> According to *Ex parte Nolden*, 149 USPQ 378, 380 (Bd. Pat. App. 1965), ("[I]t is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently

toward the desired result") (MPEP 2172.01).

In any event, Applicants submit that there is an interrelationship between the elements. For example, claim 1 clearly discloses the tapered thimbles to guide and facilitate delivery of a ball into a channel formed between the endless belt and at least a surface of a portion of the track rail covers. Claim 1 further discloses the ball lift mechanism having opposed pulleys connected by an internal frame structure, track rails opposing the opposed pulleys, and an endless belt positioned about the opposed pulleys. Certainly, one skilled in the art would understand the interrelationships of the ball lift mechanism elements, when disclosed so clearly in Applicants specification (Page 5, lines 25-29; page 6, lines 1-21; page 7, lines 15-29 and page 8, lines 1-10) and claims (claim 1).

Anyway, the MPEP does not require the structural relationship between the belt, rails, rail covers and thimbles since the claims recites a ball return mechanism and one skilled in the art would understand the structural relationship of the belt, rails, rail covers and thimbles.

MPEP 2172.01:

> In addition, a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under **35 U.S.C. 112**, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). >But see *Ex parte Nolden*, 149 USPQ 378, 380 (Bd. Pat. App. 1965) ("[I]t is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result"); *Ex parte Huber,* 148 USPQ 447, 448-49 (Bd. Pat. App. 1965) (A claim does not necessarily fail to comply with 35 U.S.C. **112**, second paragraph where the various elements do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve independent purposes.).

Applicants respectfully note the 35 U.S.C. §112, Second Paragraph of claims 1-22 is incorrect, since the claimed invention is for the gripper kit for installation on a ball return

mechanism, not the ball return mechanism.

As to the rejection of claim 3, Applicants respectfully note that such language is clear and definite. As stated above, Applicants respectfully submit the structural relationship between the elements is not necessary in the claimed invention. The claimed invention is directed to a gripper kit for use in a ball lift mechanism. Applicants submit that one skilled in the art would know the interrelationships of the elements of the ball lift mechanism, including the relationship between the bracket and the remaining elements recited.

As to the rejections of claims 7 and 18, Applicants respectfully note that such language is clear and definite. Specifically, claims 7 and 18 require the thimbles to be made in a single or multi-piece construction. This is certainly a further limiting factor concerning the thimbles, since these elements were not previously recited in the respective independent claims.

As to the rejection of claim 9, Applicants respectfully note that such language is clear and definite. Specifically, claim 9 is supported in the specification on page 10, lines 10-20. The term "slip resistant" is not indefinite as being a relative term with no given means of comparison, since the specification clearly defines the material properties of the thimbles. (Page 10, lines 10-29 and page 11, lines 1-4) In order to expedite prosecution of the present invention, Applicants have replaced "other", with - - a - -, in claim 9.

As to the rejections of claims 10-12, Applicants respectfully note that such language is clear and definite. Specifically, claim 10 requires the thimble to be adjustable to provide multiple wear areas. This is due to the fact that the thimble can be loosened from the assembly, rotated, and retightened (page 10, lines 21-29 of Specification). Claim 11 provides that the thimble shortens the time for the ball to return to a waiting stage allowing for a more efficient operation to the waiting bowler. (pages 10-11 of Specification) Claim 12 requires the thimbles reducing the number of times a ratchet assembly actuates to lift a

ball into the ball return entry area. (pages 10-11 of Specification) Applicants submit that all of these elements further define the claimed invention.

As to the rejection of claim 17, Applicants respectfully note that such language is clear and definite. In order to expedite prosecution of the present invention, Applicants have replaced "trail rail", with - -thimbles have a taper outer - -, as well as deleted "are", in claim 17.

Applicants assert that the 35 U.S.C. §112, Second Paragraph of claims 1-22 have been overcome and request withdrawal of the same.

35 U.S.C. §102 Rejection

The Office Action rejects claims 1-2 and 4-19 under 35 U.S.C. §102 over U.S. Patent Applicant No. 6,368,228 to Lanzetta ("LANZETTA"). This rejection is respectfully traversed.

The invention relates to a gripper kit for installation on a ball lift bowling ball return mechanism having opposed pulleys connected by an internal frame structure, and track rails opposing the opposed pulleys is provided. The gripper kit includes an endless belt positioned about the opposed pulleys and track rail covers covering the track rails. Additionally, tapered thimbles guide and facilitate delivery of a ball into a channel formed between the endless belt and at least a surface of a portion of the track rail covers.

LANZETTA discloses a covered rail assembly for the bowling ball return of a bowling alley (Fig. 1-2 and Col. 2, lines 11-35). The ball return assembly (10) includes a ball elevating mechanism (11) having an endless belt (11A) which engages a bowling ball (14) to roll up the latter via a rail assembly (12) (Fig. 1-2 and Col. 2, lines 11-16). The rail assembly (12) (Fig.3) comprises a pair of laterally spaced rails (16, 16A). On each of the rails (16, 16A) is a cover (C) having four sections, namely, the lower (17), intermediate (18,19) and upper (20). LANZETTA shows the lower portion (17) of the cover (C) of an open concave semi-cylindrical shape, as seen in Fig. 3 and is closely received on the periphery of the rails (16, 16A)(Fig. 4-6 and Col. 2, lines 32-47). The lower section (17) is

placed on the lower end of rail (16, 16A) with its base end (B) projecting downwardly and its upper end (17C) projecting upwardly that has two ties (19W) therein (Fig. 2-6 and Col. 2, lines 40-47). The lower section (17) of the cover (C) is an open concave semi-cylindrical shape, as seen at (22) and are closely received on the periphery of the rails (16, 16A) (see Fig. 4-6 and Col. 2, lines 32-47).

CLAIM 1

The Examiner is of the opinion that LANZETTA discloses all the features of the claimed invention concerning independent claim 1. In particular, the Examiner is of the opinion that LANZETTA shows tapered thimbles. Applicants respectfully disagree with the Examiner. The lower section (17) of the cover (C) is not a thimble. The lower sections (17) of the cover (C) clearly does not cover the end of the rail (16,16A). The lower section is merely a cover that is an open concave semi-cylindrical shape that is closely received on the periphery of the rails (16). (Col. 2, lines 32-35) Thus, the lower section is not a thimble as recited by the claimed invention.

Thus Applicants respectfully request that the Examiner reconsider and withdraw the rejection of the claims under 35 U.S.C. §102 and indicate that these claims (and all depending claims 1-2 and 4-19) are allowable.

CLAIMS 6-12

The Examiner is of the opinion that LANZETTA discloses all the features of the claimed invention concerning dependent claims 6-12. In particular, the Examiner is of the opinion that LANZETTA shows thimbles. Applicants, respectfully disagree with the Examiner. For the reasons stated above, the lower section (17) of the cover (C) is not a thimble, and does not cover the end of the rail. Thus, the lower section is not a thimble as recited by the claimed invention. Also, dependent claims 6-12 are allowable by virtue of their dependency on allowable claim 1.

CLAIM 13

The Examiner is of the opinion that LANZETTA discloses all the features of the

claimed invention concerning independent claim 13. In particular, the Examiner is of the opinion that LANZETTA shows thimbles, as well as a tension bracket having elongated slots for adjustment of position of a ball lift without removal of the tension bracket. Applicants, respectfully disagree with the Examiner.

For the reasons stated above concerning the thimbles, the lower section (17) of the cover (C) is not a thimble, and does not cover the end of the rail. Thus, the lower section is not a thimble as recited by the claimed invention. Also, LANZETTA is not a gripper kit, in any event.

Also, LANZETTA discloses a bracket fixed to the internal frame of the ball lift mechanism (10) in Figures 1-2. Contrary to the Examiner's assertions, the bracket does not disclose the Applicant's claimed invention. Nowhere in the disclosure of LANZETTA, or for that matter, any cited prior art of record, is disclosed Applicant's claimed invention of a tension bracket having elongated slots for adjustment of position of a ball lift without removal of the tension bracket. Matter of fact, LANZETTA does not show a tension bracket attaching a mechanical linkage to the frame structure, as claimed by Applicant's invention. Thus, the lower section is not a thimble, and the bracket is not a tension bracket as recited by the claimed invention.

CLAIMS 14 and 16-19

The Examiner is of the opinion that LANZETTA discloses all the features of the claimed invention concerning dependent claims 14 and 16-19. In particular, the Examiner is of the opinion that LANZETTA shows thimbles. Applicants, respectfully disagree with the Examiner. For the reasons stated above, the lower section (17) of the cover (C) is not a thimble, and does not cover the end of the rail. Thus, the lower section is not a thimble as recited by the claimed invention.

35 U.S.C. §103 Rejection

Claims 3 and 20-22 are rejected under 35 U.S.C. §103 (a) Rejection under LANZETTA in view of U.S. Patent No. 3,690,743 to Flototto ("FLOTOTTO"). This rejection is respectfully traversed.

First and foremost, it does not appear that the Examiner is properly rejecting claims 3 and 20-22. For example, the Examiner does not ever address many of the features of independent claim 20. Illustratively, the Examiner never addresses the use of thimbles, as recited in claim 20, which LANZETTA does not disclose, as discussed above. Also, the combination of references do not recite such feature.

In any event, the combination of references do not show the remaining features of the invention. For example, none of the references show a bracket with a series of elongated slots that provide the capability of adjustment. ERNST discloses a fixed bracket (80) fastened to the rod (54) in Figure 1. There is no adjustable mechanism, although ample opportunity was provided in the ERNST reference. There is simply no support for such a proposition. This is clearly shown by the detail disclosure and drawings of ERNST. In fact, it would appear to each away from an adjustable mechanism. As for the use of FLOTOTTO, this is clearly impermissible since FLOTOTTO is directed to furniture, not a ball lift mechanism. There is absolutely no motivation to make such an argument in view of the divergent arts. If anything, Applicants submit the Examiner is using impressible hindsight based on Applicants disclosure.

Applicants note, the FLOTOTTO reference has absolutely nothing to do with a ball lift mechanism, and one skilled in the art would not look to furniture or desks when addressing ball lift mechanism issues. Certainly, the Examiner's assertion is incorrect in finding a suggested teaching, or support, or motivation in applying the FLOTOTTO reference. Thus, it would appear that the rejection is faulty on its face.

Accordingly, Applicants request that the Examiner reconsider and withdraw the rejections of claims 3 and 20-22 under § 35 U.S.C. 103(a) and indicate that these claims (and all depending claims 21-22) are allowable.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 19-0089.

Respectfully submitted,

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